



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,048	12/07/2000	Michael Paul Wolf	52292-023	1251

7590 12/07/2001
MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

LE, MARK T

ART UNIT	PAPER NUMBER
----------	--------------

3617

DATE MAILED: 12/07/2001

AS

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,048

Applicant(s)

WOLF ET AL.

Examiner

Mark T. Le

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 4-29, 32-43, 62-69 and 76-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 30, 31, 44-61, 70-75, 90 and 91 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

Art Unit: 3617

DETAILED ACTION

1. Applicant's election with traverse of Group I in Paper No. 8 is acknowledged.

The traversal is on the ground that Groups III, VI, VIII are not subcombinations as relied by the examiner, but rather, are combination claims that define various features of the same combination of a model train systems. This is not found persuasive because clearly the claims of Group I and the claims of Groups III, VI, VIII do not define the same combination; the focus of each group is different from each other and is significant enough to define an independent invention; and the task of searching and considering these many Groups of invention would be a serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. The abstract of the disclosure is objected to because phrases that can be implied, i.e. "The present invention provides ...", "Disclosed is ...", "feature disclosed is...", "The present invention also discloses ...", and "are also discloses", recited throughout the abstract, should be avoided. Correction is required. See MPEP § 608.01(b).

3. Claims 72 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 72 and 74, "the Internet" lacks antecedent basis.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3617

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Young et al (US 5,251,856).

Young discloses a model train system as recited in the instant claims, including remote control unit 114, track interface unit 110, and track layout 60.

Regarding the claimed signal being in the form of a wide bandwidth or a spread spectrum signal, it is the examiner's position that the signal of Young generated by frequency shift key (FSK) modulation technique is readable as having wide bandwidth and spread spectrum, as broadly recited in the claims.

6. Claims 70-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Wigmore's article "The Digital Model Train - Part 1".

Wigmore, Figure 1, shows a model train system including a track layout, an interface unit, and a computer/information appliance as recited in the claims.

Regarding claimed features, "the model train providing operating information to said track interface", "said information appliance uploads said operating information to the Internet", "said information appliance downloads information from the Internet", they are at most related to the method steps of operation or the intended uses, which do not constitute a patentable significant in the instant apparatus claims. The claimed features are considered meet because structure in Wigmore are capable of performing the intended uses or operations.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3617

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-3 and 90-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Westlake (US 6,281,606).

Westlake discloses a model train system, as recited in the claims, including remote control 12, and track interface unit 5; wherein, data processors including memory devices are provided for storing sets of commands, as broadly recited in instant claims.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 3617

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al (US 5,251,856) in view of Pierson (US 6,014,934).

Young discloses remote controlled model train system having base components similar to that of the instant claimed invention, including remote control unit 114, track interface unit 110, and track layout 60. Young does not disclose special effect features, i.e. a sound system and a smoke unit.

Pierson discloses a train control system including special effect features, including light, sound, and smoke units.

In view of Pierson, it would have been obvious to one skilled in the art to add special effect features, similar to that of Pierson, to the structure of Young for performing the special effects; thereby, giving the train system of Young a more realistic look.

11. Claims 44-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Westlake (6,281,606) or Young et al (US 5,251,856).

Westlake and Young disclose remote controlled model train systems similar to that recited in the claims, except that Westlake and Young do not provide feedback signals to operators as acknowledgements for train conditions and status of operator commands. Such feedback information feature between remote control systems and the associated computerized controlled operating systems is merely a common technology. According, as a matter of common knowledge, it would have been obvious

Art Unit: 3617

to one skilled in the art to apply such common technology to the system of Weslake or Young to provide feed back information concerning operating conditions and command status so as to provide operators more resources for better operations.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Le whose telephone number is 703-308-3663. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 703-308-0230. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Mark T. Le
Primary Examiner
Art Unit 3617

mle
December 5, 2001